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WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			EXAMINER PIERCE, WILLIAM M	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/625,020
Filing Date: July 23, 2003
Appellant(s): PARSONS, KEVIN L.

MAILED
DEC 13 2007
GROUP 3700

L. Friedman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/31/07 appealing from the Office action
mailed 9/11/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Claims 57, 58, 62, 63, 80 and 92-95 are objected to as being dependent upon a rejected base claim. These claims are not at issue for review by the Board.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,776,429	DeLucia	12-1973
6,283,609	Parsons	9-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

Claim 57, 58, 62, 63, 80 and 92-95 are objected to as be dependent upon a rejected base claim objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claim 55, 80 and 92-95, DeLucia shows a dispenser 32 to receive a cartridge 44 having an orifice 62 in a forward portion. He further shows an actuator 130 and a cap of elements that could be considered elements 96 and 122 combined. However, both elements are not capable of moving from a first and second positions and being depressed radially in a different position. Likewise the actuator mechanism of Chen is similar, however the cap 58 does not move from a first to a second position. Pierpoint shows an electronic button. In Cellini, button 40 must be depressed before actuator button 34 can be slide forward. Examiner could not find the claimed safety button in the broad prior art of actuator buttons, switches or triggers with the functions recited in the claims.

Claim Rejections - 35 USC § 112

Claim 55 (and claims 56, 59-61 and 64-73 which depend therefrom) are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential

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elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements in claims 55, 56, 59-61 and 64-73 are the actuator button. The specification does not disclose where the apparatus can function without the actuator button cooperating against the actuator. Claims 57, 58, 62 and 63 are merely objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims since they positively recite and include the actuator button.

With respect to claims 55, MPEP 2172.01 sets forth that, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 30 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965). Here the specification only sets forth a movable cap in combination with an actuator button (78). Nothing in the specification supports the working combination of just a movable cap with an actuator for movement in an axial direction. At [0057] of the specification it only sets forth "depression of the actuator button 78 when the safety slide button 80 is in a position enabling depression causes the plunger actuator 72 to move..." There is no disclosure that his invention is workable absent the actuator button. Absent the combination of the actuator button as an essential element, there is no way the depressing the cap can cause the actuator to move. Hence the scope of the claim is unclear. One could argue

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based on applicant's position that the actuator button is implicitly recited because the actuator would not move without it or that anything that causes the actuator to move upon pressing the button would be within the scope of the claim. Obviously, permitting such argument is not permissible and the scope of the claim must be rendered definite.

Claim Rejections - 35 USC § 103

Claims 75-79, 81-91 and 96-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLucia 3,776,429 in view of Parsons 6,283,609.

As to claims 75-79, 83, 84, 85, DeLucia shows a dispenser 32 to receive a cartridge 44 having an orifice 62 in a forward portion. He further shows an actuator 130, button 122 and end 16 capable of connection between an end cap. DeLucia does not discuss the connection of his device with a baton. Parsons '609 teaches combining apparatus such as that of DeLucia with a baton in order to be able to additionally use it to strike a person. To have combined a baton capable of attaching at end 16 would have been obvious as taught by Parsons in order to make it a more effective striking weapon. As to claims 81 and 82, DeLucia shows a nozzle plate 25 that is inherently interchangeable with a replacement for repair meeting the limitations of the claim. As to claims 75, 86 and 87, element 46 is considered to be an insertable sleeve. As to claim 88, making sleeve 34 of foam is considered to be an obvious matter of choice in materials. Applicant has not shown were such a material is critical to the claimed invention by solving any particular problem or producing any unexpected results. As to claim 89, the discharge orifice is considered to be axial aligned to the nozzle of the

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cartridge via tube 64. As to claim 90, the tubular body at 46 coupled to the coupling connector 34.

With respect to applicant's remarks to claim 86, the interpretation of DeLucia as been clarified as element 46 being a slidable sleeve. Contrary to applicant's position, 46 is considered to meet the limitations of "slidingly insertable sleeve" in that the "capsule 44 which is longitudinally slidable within a sleeve 46" (col. 2, ln. 41) as disclosed. Whether or not DeLucia discloses that his sleeve 46 is movable or can operate without is immaterial since such features are not set forth in the claims.

As to claim 78, 138, or 124 for that matter, is considered to be a guide pin and 128 a spring about the guide pin.

As to claims 81 and 91, it recites a nozzle plate which is shown by 25 of DeLucia. The nozzle plate being interchangeable is considered functional and does not distinguish over the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The claim does not clearly recite that the plurality of nozzle plate are positively part of the claimed combination. It is apparent that they are part of the functional recitations of the claim. Even if positively recited, interchangeable lens plates are known to flashlights like DeLucia.

As to claim 84, element 24 is considered to be a removable retainer supporting the nozzle plate 25 and defining the discharge orifice 66. Sealing removable retainers

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as called for in claim 85 is considered old and well known as are grip enhancing surfaces such as knurled surfaces as called for in claim 88..

(10) Response to Argument

a. Claim 55 under 35 USC 112

Appellant argues at the bottom of pg. 6 of his Brief that "the claim" does "not and need not recite whether the cap acts directly on the actuator or whether there are intervening components". He continues to argue his point of view with respect to the case law to *Metabolite Laboratories* and *Venezia* through his pg. 7. He applies these cases with the argument that "the claims must have a meaning discernible to one of ordinary skill" (pg. 6, ln. 14) and that he feels it is sufficient (pg. 7, ln. 15) that one skilled in the art would be able to figure out from the functional relationship between only the cap and the actuator that there is some mechanical "cause" (ln. 15) responsible for the actuator movement. The examiner clearly disagrees and such is the basis for the grounds for rejection set forth above. Here appellant has not "distinctly claimed the invention" since the claims require a degree of precision and are not to be left open for one skilled in the art to determine or guess that there is "some sort of element" that causes a subsequent mechanical movement. Moreover, nowhere in the specification is there a combination of elements drawn only to a cap and a linear actuator. The entire disclosure is drawn to the combination of a cap, an actuator button and a plunger actuator (80, 78 and 72 from fig. 5). Such a combination as claimed has no real discernible meaning to one skilled in the art since the specification does not disclose

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how such a device is operable with only the combination of a cap and plunger actuator. The fact that appellant's disclosed invention cannot function without the actuator button 78 make it clear that he has not distinctly claimed his disclosed invention as required. It is clear that here that, where one is trying to claim beyond or what is not disclosed in the specification, such is not proper and this grounds for rejection should be sustained.

While the examiner did not also reject the claims under 112, 1st, he does now here recognize the suggestion in practice that an incomplete claim should also be rejected under the first paragraph of 35 U.S.C. 112 as based upon a disclosure which is not enabling. In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See MPEP § 2164.08(c). Clearly, every aspect of appellant's specification discloses that the actuation button is a critical feature to his invention and to the operability of his device. This is not a "merely preferred" element, but one that must be present and necessary for appellant's disclosed invention to function. This position of the examiner is discussed in MPEP 2164.08(c).

Lastly, on pg. 8, appellant discusses *Rambus*. However, this case only dealt with the issue of enablement and did not deal with the situation at hand where the omitted elements were disclosed in the specification as being critical features to the disclosed device. Where in *Rambus* one skilled in the art would recognize what is required in the prior art to make the claimed memory device operable, this is not on point with the situation here. Absent a actuator button, one skilled in that art would be left blank to figure out how to move the actuator plunger. True, cams, linkages and even electronic solenoids could possibly be used to be acted upon by the cap to move the actuator

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plunger, but none of this is supported by the disclosure. One skilled in the art would be left to guess which of a multitude of mechanical elements could possibly be used to perform the functions necessary. This is clearly improper. Further it is submitted that the claim is not being interpreted in any way to be entitled to the provisions under 112, sixth paragraph. As such, appellant's remarks are unpersuasive and the rejection should be sustained.

b. Claims 56-73

Claims 56-73 are rejected only being base upon the rejection of claim 55. More aptly, claims 57, 58, 62 and 63 are objected to in that they would be allowable since they positively recite the combination of an actuator button which is the essential element required overcome the rejection of the base claim 55. As such claims 57, 58, 62 and 63 are not considered rejected for the purposes of this Appeal.

c. Claims 75-79 and 81-102 are obvious over DeLucia in view of Parsons

1) Claims 75-77, 79, 82, 83 and 87-90

With respect to claim 75 and its dependant claims, DeLucia shows a "slidingly insertable sleeve for holding a pressurized spray cartridge" in his element 46. While applicant argues that 46 is not "slidingly insertable" in that it is "fixed", this argument is not based on the broadest reasonable interpretation of the limitations in the claims. In DeLucia, his cartridge 44 is clearly "slidingly insertable" into the sleeve 46 where he explicitly describes "capsule 44 which is longitudinally slidable within a sleeve 46" (col. 2, ln. 41) clearly meeting the limitations of the claims. Alternatively, most broadly in the assembly of the device shown by DeLucia, the sleeve 46 must be slid into the front

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chamber 34 making it meet the limitations that it is “slidingly insertable”. While appellant considers examiner’s rejection to be a “misreading” of the claims, the rejection is in fact based on the lack of precision and the examiner affording the claims their broadest reasonable interpretation in view of the applied art. With respect to any meaning to be afforded to the term “slidingly insertable” from paragraph. 44 of appellant’s specification, it merely states that the sleeve must be of “an outer diameter that enables the sleeve to be slidingly inserted within the cylindrical body 28” (ln. 4). Such is commensurate with the examiner’s interpretation of the meaning of the term. Note that nothing in the claims, ordinary meaning or the meaning afforded to the term by the specification preclude the sleeve from being fixed as argued by appellant and the grounds for rejection should be sustained.

2) Claims 91 and 96-100: References Show Interchagable Nozzle Plates as Set Forth in the Grounds for Rejection above.

With respect to claim 91, DeLucia clearly shows 1) a nozzle plate 25 that is clearly capable of be interchanged upon the disassembly of head portion 17, 2) defining a discharge orifice 66 and 3) is capable of being replaced by different plates with different outer surfaces. Note that an exact reading of the limitations of this claim only requires a “nozzle plate supported within the forward portion and defining the discharge orifice”. In DeLucia there is a nozzle plate 25 in the forward portion 17 that “defines” the orifice 66 that clearly anticipates the language of the claim. Further the claim recites that the nozzle plate needs only be capable of “being interchangeable with any one of a plurality of nozzle plates”. One skilled in the art would see that it is an inherent

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capability to interchange the plate 25 of DeLucia with any one of a plurality of other plates to repair it should it become broken or of a different color for signaling. With respect to the grounds for rejection, the prior art most broadly needs to be interpreted such that it reasonably suggests the ability to be able to change the plate. This reasonable interpretation is set forth in the grounds for rejection above. The fact that the appellant has another reason for interchanging plates of DeLucia cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Where appellant acknowledges the interchangeable nature lens plates like that of DeLucia at the bottom of pg. 10 of the Brief, he argues that "it would not make sense to use a different plate behind the DeLucia lens in order to reveal the chemical dispersing use of the device" (pg. 11, ln. 2). Once again this limitation one of intent and is not structural such that it distinguishes over that of DeLucia. Hence, the functional recitation in the claims fails to overcome the grounds for rejection and such should be sustained.

3) Claim 78 is considered shown.

Claim 78 merely recites "a guide pin for guiding movement of the actuator button" with no further structural limitations. The examiner is free to choose any element such as 138, or element 124 for that matter, to read on this claimed element. Each element is considered capable of guiding the movement of the actuator button 130 of DeLucia where they both move when button 122 is pressed. Note that this language in the claim is not considered to invoke the provisions of 112, sixth paragraph.

Where appellant argues that 138 in no way guides the movement of the plunger (pg. 12, ln. 1), such is not considered true when one views fig. 2. When one presses the button 122, this causes movement of elements 138 and 124 which causes movement, or "guides" the movement to use the language of the claim, of element 130. This interpretation shows that the claims fail to clearly distinguish over the applied art and the grounds for rejection should be sustained.

As set forth in the grounds for rejection above, element 128 of DeLucia is considered a spring "about the guide pin" which clearly meets the limitations of the claim such that it is not allowable.

4) Claim 81

Claim 81 is not allowable for the reasons set forth above with respect to claims 75 and 91.

5) Claim 84

Appellant argues that an annular retainer supporting the nozzle plate is not shown (pg. 12, ln. 22). However, retainer 17 of DeLucia is considered to be an annular retainer that supports the nozzle plate 25 and defines a discharge orifice 66. Where appellant argues that the "wall 60 is not supported by an annular retainer" (pg. 13, ln. 5), such is off point with the language of the claim. The claim merely recites that the "nozzle plate supported within the forward portion by the annular retainer and defining the discharge orifice". Clearly viewing fig. 1 of DeLucia we can see that his retainer 17 supports plate 25 within a forward portion and defines a discharge orifice at 66.

6) Claim 85

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Where appellant admits that sealing members are known, the rejection of this claim should be affirmed. Clearly one skilled having DeLucia and facing the problem of water or dirt intruding into the flashlight around the nozzle plate 25 would consider using a seal such as an o-ring in cooperation with the nozzle plate. Neither here in earlier prosecution has appellant make of record where such solves any other problem or produces any other unexpected results. As such, the rejection of this claim should be sustained.

7) Claim 86

The rejection of this claim should be sustained for the reasons set forth above with respect to claims 75 and 91.

8) Claims 92-95

Claim 92 calls for limitations found to be allowable in claim 55 for the reasons set forth at the end of the Final Rejection. As such, appellant's arguments are considered moot and no further consideration by the Board is deemed necessary.

9) Claim 101 and 10) 102

This claim remains rejected for the reasons set forth above respectively with respect to claims 84 and 91 and 85 and 91.

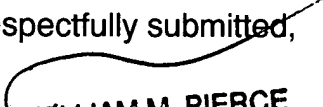
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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